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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,540	03/01/2004	Hanson S. Gifford III	HRT-0256C2	2779
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PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER PRIDDY, MICHAEL B	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 10/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,540

Applicant(s)

GIFFORD ET AL.

Examiner

Michael B. Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 37 and 46 are objected to because of the following informalities: in line 2, "member" should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-37 and 39-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Tovey et al. (US Patent Number 5,478,354), cited by applicant on 1449, paper number 12212005.

Tovey et al. disclose various embodiments of a device for engaging tissue having a preexisting opening comprising an annular-shaped ring 92 having a width disposed about a central axis, a tubular member 99 a driver (see column 4, lines 39-40 and 55-56), wherein the driver and the tubular member are movable with respect to one another, and staple members 94 extend from and integrally formed with the ring, having a thickness extending from the ring each having a

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distal portion formed of an super elastic and shape-memory material, the distal portions having a first configuration, where the distal portions are separated by a first distance and wherein the distal portions are substantially parallel to the central axis, and a second configuration, where the distal portions are separated by a second distance, the second distance being less than the first distance, wherein the width of the annular-shaped ring is greater than the thickness of the staple members (see embodiments of figures 8-11, column 4, lines 32-67, column 5, lines 47-59, and column 6, lines 20-37). The first distance is greater than the diameter of the opening and the second distance is less than the diameter of the opening (see embodiments of figures 8-11, column 4, lines 32-67, column 5, lines 47-59, and column 6, lines 20-37). The distal portion of the staple members is substantially orthogonal to the central axis when the distal portions are in the second position and the distal portion has a sharpened point (see embodiments of figures 8-11, column 4, lines 32-67, column 5, lines 47-59, and column 6, lines 20-37). In addition, the distal portions are located radially inward relative to the annular ring when the distal portions are in the second configuration, and the distal portions of the staple members are not parallel with the central axis when the distal portions are in the second configuration (see embodiments of figures 8-11, column 4, lines 32-67, column 5, lines 47-59, and column 6, lines 20-37).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Tovey et al., which is capable of being used as claimed if

one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

Claims 38 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tovey et al. as applied to claims 21-37 and 39-46 above, and further in view of the following.

Tovey et al. teach all of the limitations of the present invention except the at least two staple members comprise at least four staple members each of the four staple members extending from the inner periphery at positions that are angularly offset with respect to one another by substantially the same angle.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of Tovey et al. having four staples instead of three, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

Applicant's arguments filed 03/23/2007 have been fully considered but they are not persuasive. Applicant has argued that the distal ends of the staples of the device of Tovey et al. are not substantially parallel to the central axis in the first configuration while being substantially orthogonal to the central axis in the second configuration. It is noted that the claims do not require the distal ends of the staples be parallel or orthogonal, only that they be *substantially* parallel or *substantially* orthogonal.

The Examiner maintains that Fig. 10 of Tovey et al. depicts the distal ends 96 of the staples 94 as being *substantially* orthogonal to the central axis while Fig. 11 depicts distal ends 96 as *substantially* parallel to the central axis.

Conclusion

Applicant's amendment (the addition of new claims 38 and 47) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is 571-272-2243. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael B. Priddy
Michael B. Priddy
October 9, 2007

EP
EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER